



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,495	05/25/2001	David E. Patterson	3017-55	4882

7590 04/25/2005

LAURENCE A. WEINBERGER
882 S. MATLACK ST., SUITE 103
P.O. BOX 1663
WEST CHESTER, PA 19380-0053

EXAMINER

ZEMAN, MARY K

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,495

Applicant(s)

PATTERSON ET AL.

Examiner

Mary K. Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/7/05 has been entered.

Claims 1, 2, 5-12 are pending. Claims 8-12 are newly added. Claims 1, 2 and 5-7 have been amended.

Applicant's amendments and arguments filed 2/7/05 have been fully considered but they are not persuasive.

Claim Objections

Claims 8-12 objected to because of the following informalities: The new claims set forth underlining, which is not appropriate for new claims. This appears to be a formatting error or word processing error. Underlining and bracketing are used to indicate amendments to previously pending claims, and are not to be used in newly presented claims. Appropriate correction is required.

Rejections maintained

Claims 1, 2, and 5-7 remain rejected and new claims 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention *for the reasons of record*.

The examiner has closely reviewed the application, the amended claims, new claims, and arguments presented. The claims are drawn to molecules, or sets of molecules, which result from a selection through a particular computer-implemented invention. No physical characteristics of the selected molecules or set of molecules are delineated by the claims. No specific molecules or classes or sets of molecules are disclosed in the specification. The

Art Unit: 1631

specification does not identify any compounds which were selected by the methods written in the claims and meet the various qualitative descriptions. The claims are a wish to encompass molecules which may in the future be determined to be selected by Applicant's methods. The selection method does not lead to the identification of a well known class of compounds or molecules. It is noted that Applicant already has patents to the methods of selection. Indeed, these pending claims are covered by the reach-through materials provided by the Examiner, as Applicant is "reaching through" their disclosure to attempt to patent molecules which they have not identified or disclosed. Applicant has amended the claims in an attempt to further identify the molecules being claimed, however, the limitation added does not specify particular molecules or compounds, or classes of compounds, but provides a qualitative description. This is not sufficient.

As set forth previously, the claims lack written description in the specification as filed. All previous arguments and explanations are incorporated herein.

Claims 1, 2, and 5-7 remain rejected and new claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial or credible asserted utility or a well established utility.

The examiner has closely reviewed the application, the amended claims, new claims, and arguments presented. The claims are drawn to molecules, or sets of molecules, which result from a selection through a particular computer-implemented invention. No physical characteristics of the selected molecules or set of molecules are delineated by the claims. Molecules that are not identified have no specific, substantial or credible utility. Molecules that are not identified have no well-established utility, as no one knows what the encompassed molecules are.

Applicant argues that methods of identifying similar molecules or molecules with similar activities have utility. The claims are not drawn to methods, but to unspecified molecules. Applicant argues that the molecules have specific structures and functions, but it is noted these change depending on how they were selected. So, no particular activity, structure or function can be assigned to the class of encompassed molecules.

As such, there is no specific, substantial and credible utility for the nonspecific, possible, virtual molecules set forth in the claims.

Claims 1, 2, and 5-7 also remain rejected and new claims 8-12 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific, substantial or credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claims 1, 2, and 5-7 remain rejected and new claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant has combined some of the arguments against the non-statutory rejection in the traversal of the utility rejection, which may have been fostered from an editing error in the previous rejection which duplicated portions of the utility rejection inside the non-statutory rejection. The examiner strives to separate them here.

The examiner has closely reviewed the application, the amended claims, new claims, and arguments presented. The claims are drawn to molecules, or sets of molecules, which result from a selection through a particular computer-implemented invention. No physical characteristics of the selected molecules or set of molecules are delineated by the claims. The molecules selected are not actually synthesized, and the claims appear to recite and/or encompass data structures.

Collections of non-specific data which are not embodied on a computer-readable media are non-statutory. Collections of data which are not concrete, tangible and useful are non-statutory. The collections of data set forth in the claims do not describe any specific molecules or specific compounds.

The claims are drawn to products that have no specific structure, or function or even any tangible identity.

As set forth previously, the claims are drawn to nonfunctional descriptive material, that is not embodied on a computer readable media. The claims are drawn to data representations of selected molecules, those molecules being selected by a particular computer-implemented method. These selected molecules are mere presentations of information or abstract ideas which

Art Unit: 1631

have not been practically applied. (see, e.g., *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ 2d 1754, 1760 (Fed. Cir. 1994) (descriptive material *per se* is not patent eligible subject matter).

No physical molecules are actually created or synthesized, and the data generated by the computer implemented method is merely a list of data structures meeting particular limitations and thresholds. See also the Report on Comparative Study in New Technologies Carried Out Under Trilateral Project WM4 accessible on the World Wide Web at:

http://www.uspto.gov/web/tws/wm4/wm4_index.htm

Conclusion

No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD can be reached on (571) 272 0718. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


MARY K. ZEMAN
PRIMARY EXAMINER
1631
4/26/05